

REMARKS

This Amendment is filed in response to the Office Action mailed on July 20, 2006. All objections and rejections are respectfully traversed.

Claims 1-32 and 34-47 are currently pending.

Claims 39-47 are added to better claim the invention.

Request for Interview

The Applicant respectfully requests a telephonic interview with the Examiner after the Examiner has had an opportunity to consider this Amendment, but before the issuance of the next Office Action. The Applicant may be reached at 617-951-3067.

Claim Rejections 35 USC § 112

At paragraphs 3-4 of the Office Action, claims 1-32, and 34-38 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In particular, claims 1, 4, 20, and 32 recite “a series of actions to perform on elements of the file access data structure.” Applicant has amended claims 1, 4, 20, and 32 with three separate examples of different actions that may be performed. Accordingly, claims 1, 4, 20, and 32 recite enough features to particularly point out and distinctly claim Applicant’s invention, and should be allowable over the §112 rejection.

In particular, claims 2, 15, and 34 recite “a critical path data structure” and “set of specific code.” Claims 39-47 give examples of the terms of art. Accordingly, claims 2, 15, 34, and 39-47 recite enough features to particularly point out and distinctly claim Applicant’s invention, and should be allowable over the §112 rejection.

In particular, claims 1, 4, 7, 16, 20, 26, 32, 34, and 37 are rejected because the elements do not appear to support the preamble. Applicant respectfully notes that representative claim 1 is a method for converting a file access data structure from a first endianness to a second endianness is accomplished by the element performing a series of actions to convert from the first endianness to the second endianness. Representative claim 1 clearly performs the preamble in lines 6-8. With respect to claim 4, lines 9-10 and claim 7, lines 4-6 clearly show the preamble being performed. With respect to claim 16, the preamble is amended, and should overcome the rejection. With respect to claim 20, lines 10-11, claim 26, lines 11-12, claim 32, lines 12-13, claim 34, lines 5-7, and claim 37, lines 5-7 clearly show the preamble being performed. Accordingly, the elements of claims 1, 4, 7, 16, 20, 26, 32, 34, and 37 perform the action stated in the preamble of their respective claim.

In particular, the Examiner states that claims 1-32 and 34-39 recite “to convert the file structure from the first endianness to the second endianness, and that the Examiner states “it appears the actual transformation is not yet taking place.” Applicant respectfully notes that “performing the identified series of actions on the elements of the file ac-

cess data structure to convert the file data structure from the first endianness to the second endianness” shows one example of the step being performed by an element of the claim, i.e., shows the actual transformation taking place. Accordingly, claims 1-32 and 34-39 should be allowable over the §112 rejection.

In particular, claims 22, 23, 28, and 29 recite “it.” Applicant has amended the claims to remove the word “it”. Accordingly claims 22, 23, 28, and 29 are believed to be allowable over the §112 rejection.

Claim Rejections – 35 USC § 101

At paragraphs 5-6 of the Office Action, claims 1-32, and 34-38 were rejected under 35 U.S.C. §101, as the claimed invention is directed to non-statutory subject matter. In particular, the Examiner states that the claims are not being limited to a practical application within the technological arts.

Applicant respectfully notes that the Board of Patent Appeals and Interferences found no “technological arts” test for determining patentable subject matter under 35 U.S.C. §101 exists. *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005).

Ex parte Lundgren states in part:

“We reverse the examiner's rejection under 35 U.S.C. § 101 (non-statutory subject matter). In reviewing the Examiner's Answer, we find the examiner refers the reader to Paper No. 60 for a statement of the rejection under § 101. We have reviewed Paper No. 60 and find that a rejec-

tion under this section of the statute is set forth on pages 4-8 thereof. The examiner states "both the invention and the practical application to which it is directed to be outside the technological arts, namely an economic theory expressed as a mathematical algorithm without the disclosure or suggestion of computer, automated means, apparatus of any kind, the invention as claimed is found non-statutory." Paper No. 60, page 7.

....

Since the Federal Circuit has held that a process claim that applies a mathematical algorithm to "produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face comfortably falls within the scope of § 101," AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999), one would think there would be no more issues to be resolved under 35 U.S.C. § 101. However, the examiner is of the opinion that there is a separate test for determining whether claims are directed to statutory subject matter, *i.e.*, a "technological arts" test.

As seen, claim 1 on appeal is directed to a process. Thus, one may wonder why there is any issue regarding whether claim 1 is directed to statutory subject matter. The issue arises because the Supreme Court has "... recognized limits to § 101 and every discovery is not embraced within the statutory terms. Excluded from such patent protection are laws of nature, physical phenomena and abstract ideas." Diamond v. Diehr, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981). However, in this appeal, the examiner has not taken the position that claim 1 is directed to a law of nature, physical phenomena or an abstract idea, the judicially recognized exceptions to date to § 101. Rather, the examiner has found a separate "technological arts" test in the law and has determined that claim 1 does not meet this separate test.

The examiner finds the separate "technological arts" test in In re Musgrave, 431 F.2d 882, 167 USPQ 280 (CCPA 1970); In re Toma, 575 F.2d 872, 197 USPQ 852 (CCPA 1978); and Ex parte Bowman, 61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001)(non-precedential). We have reviewed these three cases and do not find that they support the examiner's separate "technological arts" test.

Our determination is that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained.

Accordingly, the use of the “technological arts” test to determine patent eligibility under §101 should not be used.

Additionally, the Examiner states that the claim must produce a “useful, concrete, and tangible result.” Applicant notes that the claims accomplish a useful, concrete, and tangible result by converting a data structure from a first endianness to a second endianness. Additionally, the method claims are tied to hardware, for example a processor.

Accordingly, claim 1-32 and 34-38 are definite under §101 and should be allowable.

All independent claims are believed to be in condition for allowance.

All dependent claims are dependent from independent claims which are believed to be in condition for allowance. Accordingly, all dependent claims are believed to be in condition for allowance.

Favorable action is respectfully solicited

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,



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